

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-25 are presently active in this case, Claims 1-4 having been amended and Claims 5-25 having been added by way of the present Amendment. Care has been taken such that no new matter has been entered by the amendments set forth herein. Support for the amendments can be found throughout the specification, for example, on page 28, line 25, through page 31, lines 17, and Figure 5, 6, and 8.

In the outstanding Official Action, Claims 1-4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. (U.S. Patent No. 6,034,832) in view of Epstein (U.S. Patent No. 6,601,046). For the reasons discussed below, the Applicants request the withdrawal of the obviousness rejection.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations recited in independent Claims 1, 3, and 4.

Claim 1 of the present application recites an information processing apparatus

comprising, among other features, recording means, storing means for storing information regarding each track of the contents as recording history information, means for determining whether a track on a first recording medium was previously recorded or not by the recording means based on the recording history information, and display means for displaying information regarding a track that was not previously recorded as determined by the determining means, wherein the display means initially indicates the track that was not previously recorded as being selected for recording by the recording means from the first recording medium to a second recording medium. Similar features are recited in Claims 3 and 4. The Applicants submit that the cited reference, either when taken singularly or in combination, fail to disclose or suggest display means that initially indicates a track that was not previously recorded as being selected for recording, as recited in Claim 1 of the present application, a display step wherein a track that was not previously recorded is initially indicated as being selected for recording, as recited in Claim 3, or code for displaying information, wherein a track that was not previously recorded is initially indicated as being selected for recording, as recited in Claim 4.

By way of illustration and not limitation, the present application advantageously provides an invention in which an audio recording managing unit (101) searches audio recording history information in stored memory, and judges whether or not audio recording history of each of the tracks of a CD exist in the memory. (See step S4 in Figure 4 and corresponding description in the specification.) Thus, the apparatus is able to determine whether the tracks have previously been recorded to the apparatus. The audio recording managing unit (101) is configured to cause the graphical user interface (GUI) unit (100) to

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check boxes of unrecorded track(s) in the display list thereof. The checked items in the check boxes (224a-224h) are used to determine the content that will be recorded. Such features are not disclosed or suggested in the cited references.

The Ichimura et al. reference describes a method, apparatus and a recording medium for a digital data copy operation of digital data between recording media on which digital data are recorded or management of digitally copied data. The Ichimura et al. reference only makes brief mention to the display unit thereof (column 8, lines 1-5), and does not disclose or suggest a display that initially indicates a track that was not previously recorded as being selected for recording. The Ichimura et al. reference does not describe specifics regarding the display thereof, and thus clearly does not teach these features of Claims 1, 3, and 4 of the present application.

Furthermore, the Applicants submit that the Epstein reference does not supplement the deficiencies of the Ichimura et al. reference described above. In fact the Epstein reference does not discuss a display unit, and thus does not disclose or suggest a display that initially indicates a track that was not previously recorded as being selected for recording.

Accordingly, the Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations recited in independent Claims 1, 3, and 4. Thus, the Applicants respectfully request the withdrawal of the art rejections of Claims 1, 3, and 4.

The dependent claims are considered allowable for the reasons advanced for the respective independent claim from which they depend. These claims are further considered

allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of their respective independent claim.

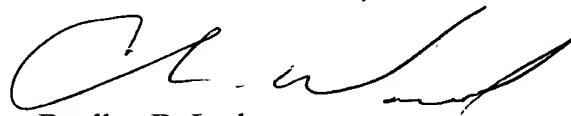
The newly added claims are believed to be in condition for allowance, as they recite features that are not disclosed or suggested by the references of record. For example, Claim 14 recites an information processing apparatus comprising, among other features, means for selecting a portion or portions of the contents for recording from the first recording medium to the second recording medium, and means for displaying indicia indicating the selected portion or selected portions, wherein the recording means records from the first recording medium to the second recording medium the displayed selected portion or selected portions. Claim 18 advantageously recites an information processing method comprising, among other features, selecting a portion or portions of the contents for recording from the first recording medium to the second recording medium, and displaying indicia indicating the selected portion or selected portions, wherein the recording step records from the first recording medium to the second recording medium the displayed selected portion or selected portions. Claim 22 advantageously recites a program comprising, among other features, code for selecting a portion or portions of the contents for recording from the first recording medium to the second recording medium, and code for controlling displaying of indicia indicating the selected portion or selected portions, wherein the code for controlling recording is configured to control recording from the first recording medium to the second recording medium the displayed selected portion or selected portions. The references of record do not disclose or suggest such features.

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Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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